

*REMARKS*Overview

Claims 1-32 are presently pending in this application. Claims 1-21 and 27-28 were withdrawn from consideration as being drawn to a non-elected invention and species. Claims 22, 30 and 31 were rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent Pub. 2002/0046635 A1 to Christen et al. (hereinafter “Christen”). Claim 32 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,080,748 to Bonomi (hereinafter “Bonomi”). Claim 32 was further rejected under 35 U.S.C. § 102(b) as being anticipated by a “standard method of disposing unwanted credit cards.” Claim 32 was still further rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. D462,965 to Pentz (hereinafter “Pentz”). Claim 23 was rejected under 35 U.S.C. § 103(a) as being obvious over Christen in view of U.S. Patent No. 2,430,720 to Kline, et al. (hereinafter “Kline”). Claims 24–26 were rejected as being obvious over the combination of Christen and Kline in further view of U.S. Patent No. 5,586,479 to Roy, et al. (hereinafter “Roy”). Claim 29 was rejected as being obvious over Christen in view of Pentz.

Claims 22-26 and 29-32 remain for consideration in this application.

Rejection of Claim 22

In light of the Examiner’s comments, claim 22 has been amended to make clear that cards of the first configuration are wallet-sized. Christen does not, nor do any of the other cited references, disclose or suggest this limitation. In contrast, Christen discloses a single sheet (10) from which *multiple* credit cards are punched out. (Christen at [0016], claim 1). As such, the sheet (10) supplied to the apparatus in Christen cannot be wallet-sized.

Additionally, Applicants respectfully reassert that Christen does not disclose supplying a succession of cards for cutting at a cutting station. In fact, Christen itself admits this omission (“This punching sheet 10 is fed to the machine by devices not shown here.” *Id.* at [0014]). Thus, Christen at most makes reference—without any enabling disclosure—to the feeding of a *single sheet*, not a succession of wallet-sized cards. Applicants respectfully request the withdrawal of the 102(b) rejection and allowance of claim 22. In the event the Examiner disagrees, Applicants

invite the Examiner to provide a specific reference to where Christen discloses supplying a succession of cards.

Rejection of Claims 23-26 and 29-31

Claims 23-26 and 29-31 are dependent upon claim 22, and thus incorporate all of its limitations. As such, claims 23-26 and 29-31 similarly contain the limitations above that are not disclosed or suggested in the cited references. Applicants therefore respectfully request the allowance of claims 23-26 and 29-31.

Additionally, Applicants note that Roy does not teach a magnetic stripe reader, as stated by the Examiner. Instead, Roy discloses that “sensors 58A and 58B each include a light source, such as a light emitting diode (LED), and a pair of photoelectric devices, such as photodiodes.” Roy at col. 4, lines 46-49. Roy does not disclose or suggest the use of any other form of sensor. Notably, the words “strip” and “stripe” do not even appear in Roy.

Rejection of Claim 32

In light of the Examiner’s comments, claim 32 has been amended to make clear that the card of the first configuration is wallet-sized and that at least a portion of the magnetic stripe does not remain on the cut card. Bonomi does not, nor do any of the other cited references, disclose or suggest this limitation. In contrast, Bonomi discloses a single sheet (20) from which multiple credit cards may be punched out. As such, the sheet (20) in Bonomi cannot be wallet-sized.

Additionally, the Examiner appears to have taken Official Notice of a “standard” method of disposing of credit cards but supplies no evidence other than a recollection of personal experience. Moreover, Applicants disagree with the Examiner regarding the functionality of a magnetic stripe on such disposed-of cards. In fact, Applicants submit that the very purpose of such cutting and disposing as recalled by the Examiner is to make the card and magnetic stripe *non-functional*—presumably to thwart misuse and identity theft—and that the prior art discussed by the Examiner is thus non-operative. See MPEP § 2121.

Lastly, the Examiner has rejected claim 32 as anticipated by Pentz. Applicants fail to see how Pentz, a design patent, anticipates each—if any—of the steps of the *method* claimed in

claim 32. For example, Pentz does not reasonably disclose or suggest steps of supplying, cutting or transporting a card, or “intrinsically punching” a hole into the card. *See* MPEP § 2125 (“The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art.”)

Moreover, the Examiner appears to have taken Official Notice that the *only* technique (hence its “inherency”) for producing a card such as those disclosed by Pentz is via a manufacturing process that supplies and transports the card to and from a cutting station, and that this process must be performed prior to “the punching station.” Applicants respectfully disagree, and invite the Examiner to provide some evidence of this assertion. *See* MPEP § 2144.03. (“Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known...It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.”)

Applicants respectfully request the withdrawal of the rejections and allowance of claim 32.

### Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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